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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,442	08/13/2001	Gen Kanai	Q65835	4176

7590 07/06/2004

SUGHRUE MION ZINN MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER
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PATTERSON, MARC A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/927,442

Applicant(s)

KANAI ET AL.

Examiner

Marc A Patterson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1,3,4,9,11,13,15,17,19,21,23,25,27,29,31,33 and 35.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See attached.

### **ADVISORY ACTION**

#### **WITHDRAWN REJECTIONS**

1. The 35 U.S.C. 112 second paragraph rejection of Claims 11, 13, 17, 19, 21, 25, 27, and 29, of record on page 2 of the previous Action, is withdrawn.

#### **REPEATED REJECTIONS**

2. The 35 U.S.C. 102(b) rejection of Claims 1, 3 – 4, 9, 15, 23 and 31 as being anticipated by Kuroda et al (U.S. Patent No. 5,079,273), of record on page 2 of the previous Action, is repeated.

The 35 U.S.C. 103(a) rejection of Claims 11, 13, 17, 19, 21, 25, 27, 29, 33 and 35 as being unpatentable over Kuroda et al (U.S. Patent No. 5,079,273), of record on page 4 of the previous Action, is repeated.

#### **ANSWERS TO APPLICANT'S ARGUMENTS**

3. Applicant's arguments regarding the 35 U.S.C. 112 second paragraph rejection of Claims 11, 13, 17, 19, 21, 25, 27, and 29, of record on page 2 of the previous Action, have been considered and have been found to be persuasive. The rejection is therefore withdrawn.

Applicant's arguments regarding the 35 U.S.C. 102(b) rejection of Claims 1, 3 – 4, 9, 15, 23 and 31 as being anticipated by Kuroda et al (U.S. Patent No. 5,079,273), 35 U.S.C. 103(a) rejection of Claim 2 as being unpatentable over Kuroda et al (U.S. Patent No. 5,079,273) and 35 U.S.C. 103(a) rejection of Claims 11, 13, 17, 19, 21, 25, 27, 29, 33 and 35 as being unpatentable

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over Kuroda et al (U.S. Patent No. 5,079,273), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below.

Applicant argues, on page 13 of Paper No. 13, that Kuroda et al does not disclose an article that is transparent.

However, as stated on page 5 of the previous Action, the transparency of the article is not claimed.

Applicant also argues, on page 13, that nothing was pointed to in the previous Action that teaches the desirability of selecting an alicyclic component having a softening temperature of not lower than 110 degrees Celsius but different from the alicyclic component disclosed by Kuroda et al.

However, Kuroda et al clearly teaches the use of polymeric components other than the disclosed alicyclic component, depending on the desired properties of the composition (column 10, lines 19 – 20) and teaches the desirability of a softening temperature of not lower than 110 degrees Celsius, as the temperature of the alicyclic component has a softening temperature of not lower than 110 degrees Celsius (column 10, lines 3 – 5). Therefore, one of ordinary skill in the art would have recognized the advantage of selecting an alicyclic component having a softening temperature of not lower than 110 degrees Celsius but different from the alicyclic component disclosed by Kuroda et al for the purpose of providing desired properties, including the softening temperature and therefore the temperature of peaks of loss tangent measured at a frequency of 1 hertz and a strain of 0.1%, as taught by Kuroda et al.

Applicant also argues, on page 14, that, even if a case of obviousness might have been established, it would have been overcome by the unexpectedly superior results of the present invention.

However, Applicant does not state what the unexpectedly superior results are.

Applicant also argues on page 14 that it is stated in the specification that when the peak temperature of  $\tan(\delta)$  exceeds the upper limit therefore, low temperature shrinkability becomes smaller and is not preferable.

However, this aspect of the invention is not claimed, and it is unclear how it distinguishes the claimed invention from Kuroda et al.

Applicant also argues on page 14 that the shrinkability disclosed by Kuroda et al is significantly less than that of the claimed invention.

However, the shrinkability of the invention is not claimed.

Applicant also argues on page 14 that the shrinkability of the claimed invention cannot be achieved unless a random copolymer having the specific ranges of softening temperature and  $t_{50}$  that are claimed is used.

However, the softening temperature of the random copolymer is not claimed.

Applicant also argues on page 14 that Kuroda et al disclose an opaque film, whereas the claimed film is transparent.

However, as stated above, the transparency of the film is not claimed.


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***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (571) 272 – 1497. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (571) 272 – 1498. FAX communications should be sent to (703) 872-9306. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

*Marc Patterson*  
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HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

2/1/04